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PATENT
Case No. DP-306837
(7500/141)NOTE?
ALL
8/18/04

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:

JACK R. KRIES, ET AL.

Serial No.: 10/092,320

Filed: MARCH 6, 2002

Title: HYDRAULIC ENGINE MOUNT
WITH CENTER-CLAMPED
DECOUPLER

Examiner: GRAHAM, MATTHEW

Group Art Unit: 3683

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Dear Sir:

Responsive to the Examiner's Answer, which was mailed on April 14, 2004, Appellants
herewith respectfully present their Reply Brief under 37 CFR 1.193(b)(1).

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The Examiner has misconstrued, and ignored, Appellants' arguments. Appellants have presented several arguments, most of which the Examiner has entirely failed to address:

- 1) The references, alone or in combination, fail to teach or disclose the claimed invention;
- 2) The Examiner used impermissible hindsight;
- 3) There is no motivation for the combination;
- 4) The suggested modification of the reference destroys the intent, purpose, or function of the invention;
- 5) The references teach away from the claimed invention.

Each of the above previously presented arguments will be further discussed below, after first addressing two points raised in the Examiner's Answer: First, referring first to Item (7) of the Examiner's Answer, the Examiner there incorrectly states that the Appellants' Brief does not include reasons in support of the proposed groupings. The first paragraph of page 6 of the Brief includes reasons for which Groups I and II are separated.

Second, referring to Item (10) of the Examiner's Answer, the Examiner alleges that Appellants claim a "periphery and not a peripheral edge" and, without citation, proceeds to define "periphery" as "a portion near the edge." Appellants submit that the Examiner's definition, while not necessarily incorrect, is inappropriately restrictive. For example, Dictionary.com¹ defines "periphery" as "the outermost part or region within a precise boundary." Webster's² defines "periphery" as "the outward bounds of something as distinguished from its internal regions or center." Similarly, Encarta³ defines "periphery" as "the area around the edge of a place."

¹ <http://dictionary.reference.com/search?q=periphery>

² <http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=periphery>

³ <http://encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861725079>

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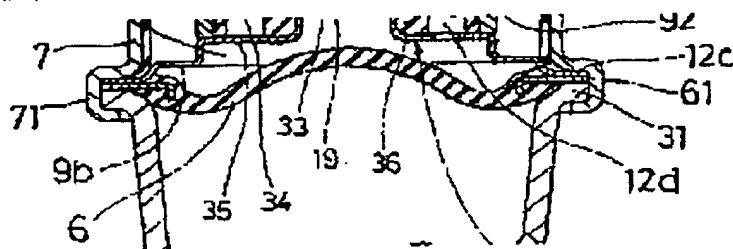
Appellants maintain that they are entitled to the broadest reasonable interpretation a person of ordinary skill in the pertinent art would have of the chosen claim language, and submit that such a person would certainly understand, and be reasonably apprised of, the scope of "periphery" when the claims are read in light of the specification.

Moreover, none of the references show, disclose, or teach, the "outermost part or region [of the diaphragm]" or "the outward bounds [of the diaphragm] as distinguished from its internal regions or center" or "the area around the edge of [the diaphragm]" "being free to move between the upper orifice plate and the lower orifice plate" as claimed in claims 1, 8, and 14. Therefore, the rejection to the independent claims, and dependent claims depending therefrom, is misplaced, and should be withdrawn.

1) The references, alone or in combination, fail to teach or disclose the claimed invention

Any review of the Yamamoto and Hein must lead to the conclusion that neither reference teaches or suggests a diaphragm periphery, or a raised rim thereof, being spaced apart from an upper and/or lower orifice plate and being free to move there between. Each reference clearly teaches the periphery of its respectively disclosed mount being restrained.

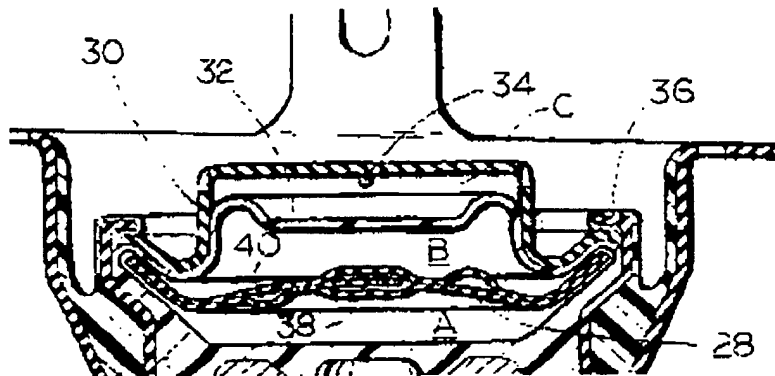
The diaphragm 6 of Yamamoto is clearly restrained as evidenced by a portion of FIG. 1 of that reference:



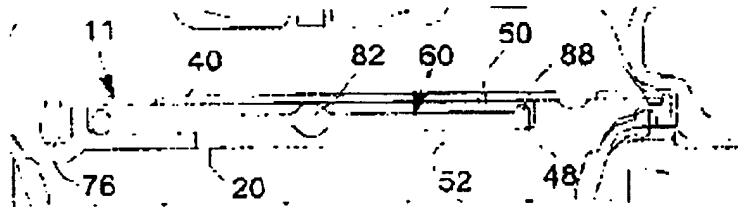
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The diaphragm 32 of Hein is similarly restrained as evidenced by a portion of FIG. 2 of that reference:



Referring to a portion of FIG. 1 of the instant application, it can be seen that the periphery of diaphragm 60, or raised rim 88 thereof, is clearly spaced apart from at least one of upper and lower orifice plates 40 and 20, and is free to move between plates.



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The cited references are both clear in their teachings – see column 7, lines 4-59 of Yamamoto and, in Hein, column 3, lines 33-48. There is no suggestion or teaching in either of these references to space the diaphragm periphery, or a raised rim thereof, apart from at least one of an upper orifice plate and a lower orifice plate, nor to allow the periphery or a raised rim thereof to freely move between such plates. Nor do either of these references disclose any motivation to provide such a structure. Even under the Examiner's limited definition of "periphery," both references fail to teach or suggest spacing apart a "portion near the edge" of the diaphragm from the upper and/or lower orifice plates

2)The Examiner used impermissible hindsight

The Examiner's formulaic response merits no reply. However, Appellants reiterate that the problem of noise in mounts, a problem addressed and solved by the claimed invention, is not addressed in Hein, and is addressed in an entirely different fashion in Yamamoto and therefore it is clear that the Examiner has based the rejection solely on knowledge gleaned from Appellants' disclosure. Hein is entirely silent about noise or sound generated by the mount, and while Yamamoto addressed the problem of sound, Yamamoto solves the problem by mating the edge of the diaphragm with the annular wall – see Yamamoto column 2, lines 66-67 through column 3, lines 1-7 reproduced below:

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3) There is no motivation for the combination

There is simply no motivation provided by the reference, nor the knowledge generally available to one of ordinary skill in the art to arrive at the claimed invention.

The Examiner correctly does not allege that the motivation is provided by the references, and therefore, apparently, is relying on the allegation that "it is well [sic] known in the art." However, the record is entirely devoid of actual evidence of the knowledge of one of ordinary skill in the art. The Examiner has not taken official notice, nor provided an Examiner's Affidavit to describe what is within the skill of one of ordinary skill in the art. Thus, the Examiner entirely lacks *actual evidence* to support his position.

Perhaps most damaging to the Examiner's case is his apparent misunderstanding of Yamamoto. With reference to Item (11) of the Examiner's Answer, at the end of the first paragraph of page 4:

decoupler or diaphragm as is taught by Hein et al. In addition, please note that the periphery is spaced apart in Yamamoto et al as broadly claimed.

To the contrary—the diaphragm periphery in Yamamoto is restrained, "and comes to abut on the partition plate member from the open end", and not spaced apart, as clearly taught and illustrated. See the section of Yamamoto previously cited and reproduced again below, as well as the FIG reproduced above.

as exhibited over a wide range of frequency bands.

Furthermore, the diaphragm portion of the rubber-like elastomer membrane in a cantilevered state slides, at its open end, toward the inner peripheral surface of the annular wall section of the orifice member and comes to abut on the partition plate member from the open end. Thus the prior art defect with the mobile plate having a valve function that it impinges on the stopper for limiting its movement in a wide area is avoided and generation of abnormal sound (hitting sound) can be reduced.

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4) The suggested modification of the reference destroys the intent, purpose, or function of the invention

The Examiner failed to address this argument. However, the Yamamoto reference teaches that the diaphragm should have a "curved configuration that nearly corresponds to the radius or curvature part 11a bulging out toward the inner peripheral surface of the annular wall section 14 of the orifice member." See, Yamamoto, column 7, lines 3-21. Hein similarly teaches that the diaphragm periphery is restrained. See, Hein, FIG. 2. These teachings would be entirely destroyed if modified to space apart the periphery. Any modification would require significant redesign, as specifically forbidden by the strictures of §103(a). See, In re Ratti, 270 F.2d 801 (CCPA 1959). Further, the general rule is that a § 103 rejection based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference is not proper and the prima facie case of obviousness cannot be properly made. In other words, where there is no technological motivation for engaging in the modification and instead a disincennve, the rejection is improper. In re Gordon, 733 F.2d 900, 902, U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

5) The references teach away from the claimed invention.

Yamamoto's above-discussed teachings that its diaphragm has a curved configuration that "nearly correspond to the radius or curvature part 11a bulging out toward the inner peripheral surface of the annular wall section 14 of the orifice member" and that its diaphragm "comes to abut on the partition plate member from the open end" unequivocally teaches away from a configuration that is spaced apart, as claimed. Thus, the §103(a) rejection is flawed on another ground.

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CONCLUSION

Appellants respectfully submit that claims 1-18 fully satisfy the requirements of 35 U.S.C. §§102, 103 and 112. For the reasons set forth in the Appeal Brief and above, it is respectfully requested that the rejections of claims 1-18 be reversed and withdrawn, and favorable consideration and early passage to issue of the present application be granted.

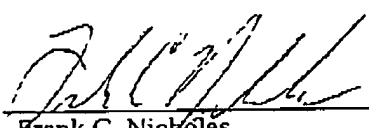
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Respectfully submitted,
JACK R. KRIES, *et al.*

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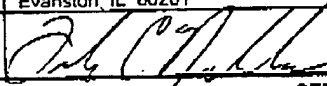
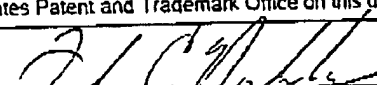
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| | Application Number | 10/092.320 |
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| | First Named Inventor | JACK R. KRIES |
| | Group Art Unit | 3683 |
| | Examiner | GRAHAM, MATTHEW |

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